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10/635,986	08/07/2003	Jay S. Walker	01-052	1612
22927	7590	02/29/2008		
WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
			EXAMINER	
			DEODHAR, OMKAR A	
			ART UNIT	PAPER NUMBER
			3714	
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			02/29/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/635,986

Applicant(s)

WALKER ET AL.

Examiner

Omkar A. Deodhar

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/10/2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Non-Final Rejection**

#### ***Information Disclosure Statement***

A signed copy of the IDS filed 10/10/2007 is provided for the Applicant's records.

#### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 23 and 24 are provisionally rejected under 35 U.S.C. 101 on the ground of statutory double patenting as being unpatentable over claims 1 and 45-48 of copending Application No. 11/424,009 and claims 1, 23 and 24 of copending Application No. 11/424,000. The conflicting claims are not patentably distinct from each other because all claims are directed toward the same invention. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 23 and 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-62 of U.S. Patent No. 6,012,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the current application would have been an obvious extension of the patented claims. Furthermore, both the application and patent are directed towards automated play gaming devices.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-14 and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al. (US 5,830,067, hereafter: Graves).**

**Claims 1 and 23-27:**

Graves discloses:

A proxy player machine, Abstract.

Data representative of a wager amount, (Col. 2. Lines 60-62);

Transmission of a plurality of different signals, (Figure 2);

Initiation of an automated play session, (Col. 3. Lines 5-13 - Machine completely takes over the game play and makes player decisions.) When the automated game session is taking place, plays are initiated without a player and the machine isn't operable for manual play. Thus, the session includes a plurality of plays not initiated by any player.

Accounting functions, (Col. 2. Lines 60-63 & Col. 3. Lines 14-19 – this teaches the various funding functions.) This also teaches that when an account has insufficient funds, gaming is terminated.

Remote player may view the proxy play and/or automated play (Col. 2. Lines 22-25.)

Note that Graves (Abstract) discloses electronic or mechanical devices, but does not explicitly state a slot machine. In Graves's system, bingo game decisions are made

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automatically. Both bingo games and slot machine games are found in casinos.

They are both games of chance that require wagering. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to extend Graves's automated decision making and game play to slot machines. This would provide a system that analyzed a player's wagering decisions and then began automated play.

**Claims 2-5:**

Locking data, (Col. 3. Lines 5-13 - Automated play is interpreted as teaching that a player is locked out of play). Automated play teaches that manual play is not taking place. This extends to a machine being inaccessible, for at least some period of time, during automated play. Note that after automatic play ends, manual play resumes.

**Claims 8-14 and 18-22:**

Communication device associated with a remote player, (Figure 1);

Handheld communication device, (Col. 3. Lines 50-53);

Communication device such as a telephone, (Col. 1. Lines 50-52);

Communication involving Internet protocol address, (Figure 1);

Graves teaches the usage of PDA's such as the Apple Newton. PDA's feature wireless communication, (Col. 3. Lines 50-53.)

Transmitting signals to a display device (video signals), (Figure 1 & Col. 1. Lines 28-40);

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Remote machine identifiers, (it is clear that players playing via proxy are aware of which machine is being played, as are remote players, see also Figure 3);

Indicators of activity such as text communications and flashing lights, (Figures 1-5);  
(Col. 6. Lines 1-5);

**Claim 6:**

Claim 6 recites a version of stacking slot machines on top of one another. It is readily recognized in the art that casino floor space is a premium and thus gaming cabinets should be designed and laid out most effectively. Additionally, even outside the art, the need for stacking components is well known. Warehouse cabinets are routinely stacked on top of one another to save floor space. Therefore, it would have been an obvious matter of design choice to a person of ordinary skill in the art to stack slot machines on top of one another. Stacking machines on top of one another is a mere design consideration failing to patentably distinguish over the prior art of record.

**Claim 7:**

Claim 7 recites a version of replacement of a casing. Replacing casings that house items is well known. One of ordinary skill in the art would readily recognize the benefits of being able to replace one casing with another, at least with respect to aesthetics. Therefore, it would have been an obvious matter of design choice to a person of ordinary skill in the art to replace casings to be aesthetically pleasing.

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Replacing casings that house items is a mere design consideration failing to patentably distinguish over the prior art of record.

**Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al. (US 5,830,067, hereafter: Graves) in view of Molnick (US 5,800,268).**

**Claims 15-17:**

Graves teaches interactive cable TV and in general, various communication mediums relying on Internet technology. However, Graves does not disclose the usage of cameras.

In a related invention, Molnick discloses a method of participating in a live casino game from a remote location. Molnick teaches the usage of video cameras located at gaming tables for transmitting images of the gaming table and dealt cards to remote players. The video cameras may be equipped with microphones thereby providing audio feedback to accompany the video, (Molnick- Col. 3. Lines 65-67 and Col. 4. Lines 1-3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have incorporated the camera technology of Molnick into the gaming system suggested by the Graves for the purpose of providing remote players audio and video feedback of live casino table games. Such feedback provides a more realistic gaming experience for remote players.

***Response to Arguments***



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Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omkar A. Deodhar whose telephone number is 571-272-1647. The examiner can normally be reached on M-F 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OAD

  
XUAN M. THAI  
SUPERVISORY PATENT EXAMINER